

**Office Action Summary**

Application No.

09/203,513

Applicant(s)

AIYAMA, KENJI

Examiner

Ashanti Ghee

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. Figure 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

2. The disclosure is objected to because of the following informalities: **spelling error on page 4, line 21; incorrect element number (step S4) on page 10, line 22; and incorrect element number (step S12).**

Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 3, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher (US Patent Number 6,188,766).

Regarding claim 1, Kocher discloses an image processing apparatus for performing image formation based on image-formation data (*evident that image-formation data is being transmitted*; column 7, lines 10-12), said image processing apparatus causing a job data to include said image-formation data and a communication procedure for communicating with an external unit (*telecopier is read as an external unit*), and controlling said image formation in accordance with a result of communicating with said external unit based on said communication procedure in said job data (*evident that digital images can be sent by telecopier*, column 7, lines 10-46).

Regarding claim 2, Kocher discloses an image processing apparatus wherein said job data is received from outside said image processing apparatus (column 4, lines 47-48).

Regarding claim 3, Kocher discloses an image processing apparatus further including image formation means (column 5, lines 10-12).

Regarding claim 10, Kocher discloses an image processing apparatus wherein said external unit is a computer (column 4, lines 47-48).

5. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher (US Patent Number 6,188,766) in view of Gordon et al. (US Patent Number 5,459,584).

Regarding claim 4, Gordon discloses an image processing apparatus wherein said communication procedure is a procedure for communicating with a charging

management unit for collecting charging information for charging each user for the utilizing condition of said image processing apparatus (*evident that billing system is managing charging collection information of the use of the image processing apparatus*; column 18, lines 45-61). Although Kocher does not specifically disclose a communication procedure, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Gordon with the teachings of Kocher to enhance the ease of facsimile transmissions and providing additional features relative to facsimile transmissions.

Regarding claim 10, Kocher discloses an image processing apparatus wherein said external unit is a computer (column 4, lines 47-48). Gordon discloses the external unit is a computer (column 12, lines 19-22).

6. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher (US Patent Number 6,188,766) in view of Barak (US Patent Number 6,046,824).

Regarding claim 5, Barak discloses an image processing apparatus wherein said communication procedure is a procedure for communicating with an image-formation-history management unit for recording the history of the utilizing condition of said image processing apparatus for each user (column 11, lines 58-67). Although Kocher does not specifically disclose a communication procedure for communicating with an image-formation-history management unit, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Barak with the teachings of Kocher to provide a long term facsimile

transmission storage system where facsimile transmissions are archived on industry standard archive devices to be stored for long periods of time.

Regarding claim 10, Kocher discloses an image processing apparatus wherein said external unit is a computer (column 4, lines 47-48). Barak discloses the external unit is a computer (Figure 1).

7. Claims 6, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher (US Patent Number 6,188,766) in view of Iwata (US Patent Number 5,117,258).

Regarding claim 6, Iwata discloses an image processing apparatus wherein said communication procedure is a restriction procedure for restricting the use of said image processing apparatus for each user (column 12, lines 66-68). Although Kocher does not specifically disclose communication procedure is a restricting procedure, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Iwata with the teachings of Kocher to provide accurate fees based on the detected size of the sheet material.

Regarding claim 7, Iwata discloses an image processing apparatus wherein said restriction procedure restricts based on the number of formed images the use of said image processing apparatus (*evident that number of images can be formed on different sheet sizes*; column 12, lines 66-68). Although Kocher does not specifically disclose restriction procedure restricts a number of formed images, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include

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the teachings of Iwata with the teachings of Kocher to provide accurate fees based on the detected size of the sheet material.

Regarding claim 10, Kocher discloses an image processing apparatus wherein said external unit is a computer (column 4, lines 47-48). Although Iwata does not disclose the external unit is a computer, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would use the teachings of Kocher to provide assurance that transmission and printing operations were successful.

8. Claims 8, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kocher (US Patent Number 6,188,766) in view of Anglin, Jr. et al. (US Patent Number 5,892,591).

Regarding claim 8, Anglin discloses an image apparatus wherein said communication procedure is used to pay a value necessary for image formation (*evident that routing information contains the billing program in Figure 3*; column 6, lines 33-39). Although Kocher does not specifically disclose a communication procedure being used to pay a necessary value, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would to include the teachings of Anglin with the teachings of Kocher to increase the speed of facsimile transmissions and lower overall cost of transmissions.

Regarding claim 9, Anglin discloses an image processing apparatus wherein said communication procedure is independent for each image to be formed (*evident that billing program is independent with each document*; column 6, lines 26-28). Although Kocher does not specifically disclose a communication procedure being used to pay a

necessary value, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would to include the teachings of Anglin with the teachings of Kocher to increase the speed of facsimile transmissions and lower overall cost of transmissions.

Regarding claim 10, Kocher discloses an image processing apparatus wherein said external unit is a computer (column 4, lines 47-48). Anglin discloses the external unit is a computer (Figure 3).

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonk et al. (US Patent Number 5,493,634).

Regarding claim 11, Bonk discloses an image processing apparatus connected to an external unit via a network, said image processing apparatus comprising (*inherent that print server is connected to printer*, column 4, lines 34-38); communication means for communicating with said external unit (column 8, lines 1-13); image processing means for generating image data from image-formation data (column 3, lines 37-44); image output means for outputting to a medium images based on said image data

(column 8, lines 63-65); and control means for controlling said image processing means and said image output means (column 3, lines 62-66); wherein said communication means receives a job data including said image-formation data and a procedure for communicating with said external unit, and said control means for executes said procedure in said job data to communicate with said external unit (column 8, lines 1-13), whereby controlling image-output processing based on said image-formation data in accordance with a result of the communication with said external unit (column 8, lines 1-24).

Regarding claim 12, Bonk discloses an image processing apparatus wherein an apparatus for supplying said job data to said image processing apparatus is connected to said network (column 4, lines 24-31).

Regarding claim 13, Bonk discloses an image processing apparatus wherein said external unit is a charging management unit for collecting charging information for charging each user for the utilizing condition of said image processing apparatus (column 8, lines 10-13).

### ***Claim Rejections - 35 USC § 103***

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonk et al. (US Patent Number 5,493,634) in view of Barak (US Patent Number 6,046,824) in further view of Iwata (US Patent Number 5,117,258).



Regarding claim 14, Barak discloses an image processing apparatus wherein said external unit is an image-formation-history management unit for recording the history of the utilizing condition of said image processing apparatus for each user (column 11, lines 58-67), and for restricting the use of said image processing apparatus based on the number of formed images. Although Barak and Bonk do not specifically disclose restricting use of image processing apparatus based on the number of formed images, Iwata discloses restricting the use of said image processing apparatus based on the number of formed images (column 12, lines 66-68). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Barak and Iwata with the teachings of Bonk to provide an accurate fee based on the detected size of the sheet material.

12. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonk et al. (US Patent Number 5,493,634) in view of Anglin, Jr. et al. (US Patent Number 5,892,591).

Regarding claim 15, Anglin discloses an image processing apparatus wherein said external unit is a charge collector for charging each user for a value necessary for image formation (*evident that routing information contains billing program in Figure 3*; column 6, lines 33-39). Although Bonk does not specifically disclose the external unit being a charge collector, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Anglin with the teachings of Bonk to increase the speed of facsimile transmission and lower the overall cost of transmissions.

***Claim Rejections - 35 USC § 102***

13. Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonk et al. (US Patent Number 5,493,634).

Regarding claim 16, Bonk discloses an image processing apparatus wherein said job data is independent for each image to be formed (*inherent that the PDL job identifiers are independent for each job*; column 4, lines 61-65).

Regarding claim 17, Bonk discloses a machine-readable recording medium for an image processing apparatus forming images based on image-formation data, said machine-readable recording medium containing a program for enabling a computer to have a function of (column 3, lines 34-46): receiving from the exterior a job data including said image-formation data and a procedure for predetermined processing (column 8, lines 1-10), and controlling image formation in accordance with the received procedure (column 8, lines 25-30).

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonk et al. (US Patent Number 5,493,634) in view of Anglin, Jr. et al. (US Patent Number 5,892,591).

Regarding claim 18, Bonk discloses a machine-readable recording medium containing a program for enabling a computer, in an image processing apparatus forming images based on image-formation data (column 3, lines 34-46), to have a function of causing a job data to include said image-formation data and a communication procedure for communicating with an external unit (column 8, lines 1-

13), and controlling said image formation in accordance with a result of communication with said external unit based on said communication procedure included in said job data.

Although Bonk does not specifically disclose controlling the image formation as a result of communication with the external unit, Anglin discloses controlling said image formation in accordance with a result of communication with said external unit based on said communication procedure included in said job data (*evident that the controlled image formation is the routing information which contains information from the billing program*; column 6, lines 29-39). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would include the teachings of Anglin with the teachings of Bonk to increase the speed of facsimile transmission and lower the overall cost of transmissions.

### **Conclusion**

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Terasaki et al.** (US Patent Number 5,715,301) discloses an in-house communication system providing telephone and facsimile service.

**Bloomfield** (US Patent Number 6,025,931) discloses a fax to email communication system with a local interface.

**Farrell** (US Patent Number 5,383,129) discloses a method of estimating cost of printing materials used to print a job on a printing apparatus.

**Miyazaki** (US Patent Number 6,275,667) discloses an image forming apparatus which can correctly recognize a function substantially used by a user.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashanti Ghee whose telephone number is (703) 306-3443 and personal FAX number is (703) 746-7455. The examiner can normally be reached on Monday-Friday (7AM - 4PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7455 for regular communications and (703) 308-5397 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Ashanti Ghee  
Examiner  
Art Unit 2622

March 6, 2002

  
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